



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,018	01/07/2004	Steven A. Sunshine	18564C-005420US	7104
22428 7590 09/19/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
HANDY, DWAYNE K				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
09/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/754,018

Applicant(s)

SUNSHINE ET AL.

Examiner

DWAYNE K. HANDY

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23, 26-31 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23, 26-31 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Inventorship

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 23, 26, 26-31 and 36 are rejected under 35 U.S.C. 103(a) as being obvious over Sunshine et al. (6,085,576) in view of Goodman et al. (6,495,892). Sunshine teaches a vapor sensing device comprised of a sensor module having a sample chamber and array that provides resistance measurements in response to exposure to an analyte (Abstract). The device is best shown in Figures 2A, 2B, 5, 7A, 7B, 8A, 8B, 9A and 11. The device is described in general in column 5, line 60 - column 7, line 7. The device may include a wide variety of sensor types (column 10, lines 25-63), circuitry and a stand for holding the array (column 11, lines 4-20), and a processor having algorithms for determining the analyte (column 13, line 32 - column 14, line 32). Sunshine does not teach the passivation layer. Goodman teaches a sensor array having a passivation layer (column 12, lines 16-65). It would have been obvious to one of ordinary skill in the art to add the passivation layer from Goodman with the system of Sunshine. One would add the passivation layer to protect the sensor array from the elements.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed

in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2). .

4. Claims 23, 26, 26-31 and 36 are rejected under 35 U.S.C. 103(a) as being obvious over Sunshine et al. (6,839,636) in view of Goodman et al. (6,495,892). Sunshine teaches a vapor sensing device comprised of a sensor module having a sample chamber and array that provides a response when exposed to an analyte (Abstract). The device is best shown in Figures 3-8. The device is described in general in column 5. The device may include a wide variety of sensor types (column 12, lines 17-36), circuitry and a stand for holding the array (column 9, lines 1, column 10, line 15), and a processor having algorithms for determining the analyte (column 15, line 18 - column 16, line 33). Sunshine does not teach the passivation layer. Goodman teaches a sensor array having a passivation layer (column 12, lines 16-65). It would have been obvious to one of ordinary skill in the art to add the passivation layer from Goodman with the system of Sunshine. One would add the passivation layer to protect the sensor array from the elements.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Response to Arguments

5. The Examiner apologizes for typographical errors in the previous Office Action (mailed 4/4/08). In Paragraph 8, the Sunshine reference used in the rejection should have been "**Sunshine et al. (6,839,636)**" instead of a repeat of patent number 6,085,576. This reference ('636) has now been used in a 103 rejection in response to Applicant's amending of the claims but since the '636 Sunshine reference was improperly cited in the previous Office Action, the Examiner has not made the current

Office Action Final. Applicant also properly assumed that the Examiner was referring to Goodman et al. (6,495,892) in the 103 rejection being made in Paragraph 11 of the previous Action. The Examiner again apologizes for the errors.

6. The Double Patenting rejections from the previous Office Action (Paragraphs 3-5) have been removed in response to Applicant's submission of a Terminal Disclaimer.

7. The Examiner has also removed the 102 rejections in response to Applicant's amending of claim 23 to include the passivation layer. The Examiner has provided new rejections in Paragraphs 3 and 4 above that address the amended claims.

8. Applicant has argued that the 103 rejections involving the Sunshine references should be removed because the instant Application has an earlier filing date. The Examiner respectfully disagrees. The Examiner agrees that the effective filing date of the instant Application is the November 15, 1999, but all references cited have effective filing dates that are earlier than 11/15/1999. The Sunshine ('576) reference was filed on March 18, 1999 and claims priority to a provisional filed March 3, 1999. The Sunshine ('636) reference was filed on June 16, 2000 but claims priority to a divisional filed March 2, 2000 and provisional filed June 17, 1999. The Goodman reference was filed on March 26, 1999 and claims priority to a provisional filed April 9, 1998.

9. Applicant has also argued that the 103 rejection should be removed due to the submission of a Terminal Disclaimer. The Examiner respectfully disagrees. A Terminal Disclaimer alone does not meet the requirements to overcome a 103 rejection based on prior art under 102(e) that involves a common assignee. The 103 rejections under the Sunshine references (or Goodman) may be overcome by meeting the conditions listed above in the second portions of Paragraphs 3 and 4.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
September 14, 2008

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797